

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

The specification and drawings have been amended to properly explore the features originally disclosed by the application, including the ability to "snuff" or extinguish a torch flame. To extinguish a torch flame, either a durable cap is required, wherein the cap is manufactured from a fire resistant material, or the internal retention volume must be equipped with fire resistant material. As such, those features are added in this amendment, and should not constitute new matter.

Please accept amended Claims 1, 3 and 4. Claims 2, 5 and 6 have been canceled without prejudice, the content of Claims 2, 5 and 6 have been incorporated into amended Claim 1. Please accept and enter New Claims 7-16.

The examiner respectfully rejected Claims 1-6 under 35 U.S.C. § 112, second paragraph, as being indefinite in providing insufficient antecedent basis for limitations provided in the aforementioned claims. Claims 1, 3 and 4 have been amended and should overcome the examiner's rejection. As noted, Claims 2, 5 and 6 have been canceled without prejudice.

The examiner respectfully rejected Claims 1 and 3-5 under 35 U.S.C. § 102(b) as being anticipated by Moore et al. ('722). Claims 1, 3 and 4 have been amended, and Claim 5 has been canceled without prejudice. Moore et al. fails to disclose the device disclosed by the present invention having an upper cover, a upper housing, an internal retention volume having a dimension of 10" by 12", a drawstring conduit and a drawstring positioned near the lower end of the housing, and drawstring retention means. Thus, the amended Claims 1, 3 and 4 overcome the

examiner's rejection and be in a condition for allowance.

The examiner respectfully rejected Claim 2 U.S.C. § 103(a) as being unpatentable over Moore et al. Claim 2 has been canceled without prejudice, and the contents of Claim 2 incorporated into independent and amended Claim 1. In addition, although the examiner is correct in stating that a *mere* change in the size/proportion of a device is generally within the ordinary skill of someone in the pertinent art, the modification in size of the present invention is motivated by a need to provide adaptability in the function of the present invention. The device disclosed by Moore et al. is designed for a post-guard of a general 6" by 8" dimension, and is noted to be particularly directed at the posts or pillars sheered from a wrecked automobile, thus fitting over the posts/pillars and protecting emergency workers. The present invention requires a larger internal retention volume dimension to accommodate the varied sizes of backyard torches. Furthermore, the present invention is affixed to the torch, via the drawstring and spring clip mechanism, to protect the bamboo or wood-like nature of the backyard torch, and as such must have a larger and more accommodating size. As such, the examiner's rejection of Claim 2 (now incorporated into Claim 1) is inappropriate.

The examiner respectfully rejected Claims 1 and 2-5 under 35 U.S.C. § 103(a) as being unpatentable over Moore et al. in view of Sturgeon or Martinon et al. Claims 1, 3 and 4 have been amended, and Claims 2 and 5 have been canceled without prejudice, with the content of Claims 2 and 5 incorporated into the content of amended Claim 1.

The differences between the present invention and Moore et al. have been discussed above.

Sturgeon discloses an ornamental design for a bingo hand bag in which the drawstring and conduit are disposed at the top portion of the apparatus, and apparently has two drawstring openings opposite one another. In contrast, the present invention has a single drawstring opening disposed at the lower end of the apparatus. Thus, Sturgeon in combination with Moore et al. fails to teach the elements as claimed by the present invention in Claims 1, 3 and 4, thus Claims 1, 3 and 4 should be in a condition for allowance.

Martinson et al. discloses a dual drawstring and conduit apparatus, disposed at the top portion of the apparatus and specifically designed to securely hold the hooks, used to hang drapes from a curtain rod, while the drapes are being laundered. In contrast, the present invention has a single drawstring and conduit disposed at the lower end of the apparatus. Thus, Martinson et al. in combination with Moore et al. fails to teach the elements as claimed by the present invention in Claims 1, 3 and 4, thus Claims 1, 3 and 4 should be in a condition for allowance.

Finally, the examiner rejected Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Moore et al. in view of Spector. Claim 6 has been canceled without prejudice and incorporated into the language of amended Claim 1.

The differences between the present invention and Moore et al. have been discussed above. Although Spector discloses a clasp, the combination of Moore et al. and Spector, especially in light of the differences between the present invention and Moore et al., fails to teach every element of the claims, thus the rejection of Claim 6 was inappropriate. Therefore, Claim 1, as amended with the content of Claim 6, should be in a condition for allowance.

Based upon the above arguments, it is felt that the differences between the present

invention and all of these references are such that rejection based upon 35 U.S.C. § 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a torch cover having an upper housing with a upper cover at one end, an orifice at an opposite end, having a drawstring, conduit and retention means, and having an

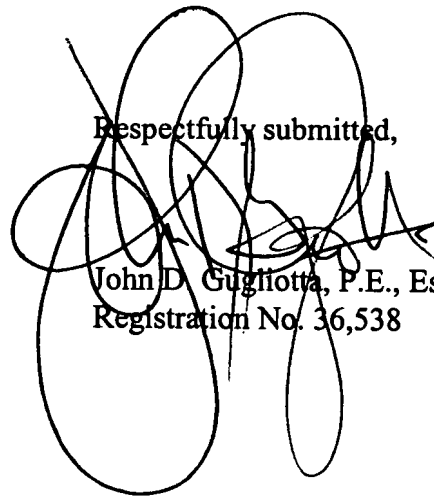
internal retention volume adapted to securely fit over a torch and protect the material from which the torch is made from the environmental elements. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Utility Patent
Ser. No. 10/005,538

Respectfully submitted,

A large, stylized handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Please add the following two paragraphs to follow the paragraph ending on line 5, page 6 of the originally filed specification:

- - The drawstring retention means 38 further comprises an integrally attached extinguishing cap 40. The extinguishing cap 40 is a cylindrical cap having a top portion 42 (corresponding to the lower wall of the drawstring retention means), a cylindrical sidewall 44 depending from the top portion 42, and a cavity 46 formed along the interior of the cap 40 by the top portion 42 and the sidewall 44. The cap 40 is placed over a torch flame so that the flame enters the cavity 46 and is enveloped by the top portion 42 and sidewall 44. The cap 40 extinguishes the torch flame by physically stamping the flame along the top portion 42. The cap 40 may then rest on the top surface of the torch until the surface sufficiently cools to receive the cover 10. The cap 40 is manufactured from a fire resistant and durable material, such as metal, stone, glass, plexiglass, acrylic, ceramic, mortar, fire resistant nylon and other similar materials, so that the cap 40 may be used repeatedly without melting, disfiguring or otherwise damaging the cap 40.

In an alternative embodiment, the cover 10 does not include an extinguishing cap 40. Instead, the internal retention volume 26 formed along the interior of the cover 10 is formed by a flame resistant nylon fiber, such as the fiber NOMEX®. Furthermore, the internal retention volume 26 may be formed by a fabric strengthening nylon fiber, such as the fiber KEVLAR®, to strengthen the fabric to withstand heat and/or manual abuse exerted on the cover 10. Thus, the

upper end of the internal retention volume 26 may act to extinguish the torch flame through physical stamping of the flame, while the flame/fire resistant nylon fibers allow the cover 10 to be secured against the top of the torch without fear of burning or severely damaging the cover 10.

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In the Claims

Claims 1, 3 and 4 have been amended. Claims 2, 5 and 6 have been canceled without prejudice.

Please accept and enter New Claims 7-16.

Please amend the following claims by deleting the language which is struck by “—” and inserting the language which is underlined “_____”.

1. (Amended) A torch cover comprising:

a generally cylindrical outer housing closed at ~~the~~ an upper end by an upper housing cover opposite an entry orifice at ~~the~~ a lower end;

a circumscribing conduit formed about ~~the~~ a lower circumference of ~~the~~ said outer housing near ~~the~~ said entry orifice and having a conduit entry; and

an internal retention volume formed within said housing of a dimension approximately 10" wide and 12" long;

a drawstring entering and exiting said conduit entry in a manner such as to entirely circumscribe ~~the~~ said lower ~~portion~~ of ~~the~~ said cylindrical outer housing; and

drawstring retention means, said drawstring retention means comprising a spring clip, said spring clip for impinging movement of said drawstring.

2. Canceled.

3. (Amended) The torch cover of Claim 1, wherein said upper housing cover is formed of light impenetrable material for impeding penetration of damaging UV-A and UV-B sunlight.

4. (Amended) The torch cover of Claim 1, wherein said cylindrical outer housing is formed of light impenetrable material for impeding penetration of damaging UV-A and UV-B sunlight.

5. Canceled.

6. Canceled.

7. (New) A torch cover comprising:

a generally cylindrical outer housing including an upper end and a lower end, said upper end integrally coupled to an upper housing cover, said lower end opposite to said upper end, said lower end forming an entry orifice;

a circumscribing conduit formed about a lower circumference of said outer housing nears said entry orifice and including a conduit entry;

an internal retention volume formed along an interior of said cylindrical outer housing;

a drawstring entering and exiting said conduit entry in a manner so as to entirely circumscribe said lower end of said cylindrical outer housing;

drawstring retention means for mechanically impinging said drawstring; and

an extinguishing cap, said cap integral to said drawstring retention means, said cap

comprising a top portion, a cylindrical sidewall depending from said top portion and a cavity formed by said top portion and said sidewall, said cap for extinguishing a torch flame.

8. (New) The torch cover of Claim 7, wherein said internal retention volume measures approximately 10" wide and 12" long.

9. (New) The torch cover of Claim 8, wherein said internal retention volume receives the flame bearing portion of a torch.

10. (New) The torch cover of Claim 7, wherein said drawstring retention means comprises a spring clip.

11. (New) The torch cover of Claim 7, wherein said extinguishing cap is manufactured from a material selected from the group consisting of metal, stone, glass, plexiglass, acrylic, ceramic, mortar and fire resistant nylon.

12. (New) A torch cover comprising:

 a generally cylindrical outer housing including an upper end and a lower end, said upper end integrally coupled to an upper housing cover, said lower end opposite to said upper end, said lower end forming an entry orifice;

 a circumscribing conduit formed about a lower circumference of said outer housing nears

said entry orifice and including a conduit entry;

an internal retention volume formed along an interior of said cylindrical outer housing, said internal retention volume comprising a fire resistant nylon fiber, said fire resistant nylon fiber for preventing fire and heat damage to said cover;

a drawstring entering and exiting said conduit entry in a manner so as to entirely circumscribe said lower end of said cylindrical outer housing; and

drawstring retention means for mechanically impinging said drawstring.

13. (New) The torch cover of Claim 12, wherein said internal retention volume further comprises a fabric strengthening nylon fiber, said fabric strengthening nylon fiber providing structural integrity to said cover so as to allow said cover to withstand repeated use in extinguishing torch flames.

14. (New) The torch cover of Claim 13, wherein said internal retention volume measures approximately 10" wide and 12" long.

15. (New) The torch of Claim 14, wherein said internal retention volume receives the flame bearing portion of a torch.

16. (New) The torch of Claim 12, wherein said drawstring retention means comprises a spring clip.